

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application: Wei Wu Serial No.: 10/556,237 Filed: November 13, 2006 For: METHOD, REAGENT, AND DEVICE FOR EMBOLIZING BLOOD VESSELS IN TUMORS WITH ULTRASONIC RADIATION MICRO-BUBBLE REAGENT	Confirmation No. 3671 Group Art Unit: 3768 Examiner: Rozanski, Michael T.
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Mail Stop Non-Final Response
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In response to the Office Action mailed August 22, 2007, Applicant requests reconsideration of the restriction requirement in light of the following remarks.

The Restriction Requirement

The Office has required restriction to one of the following groups of inventions under 35 U.S.C. § 121:

Group I: claims 15-20; drawn to a method for embolizing blood vessels, classified in class 601, subclass 2;

Group II: claims 21-22; drawn to method for reducing the size of a tumor, classified in class 601, subclass 2;

Group III: claims 23-24; drawn to method for treating cancer, classified in class 601, subclass 2;

Group IV: claims 25-33; drawn to an ultrasonic micro-bubble reagent for causing embolus, classified in class 601, subclass 2;

Group V: claims 24-38; drawn to a medical device for forming capillary vessel embolus, classified in class 601, subclass 2; and

Group VI: claims 39-42; drawn to an ultrasonic treatment head for a device for forming method for forming capillary vessel embolus, classified in class 601, subclass 2.

The Office argues that the Groups are related to ultrasound applications and are distinct since the Groups of claims have a materially different design or mode of operation for the reasons detailed on page 3 of the Office Action, do not encompass overlapping subject matters, and there is nothing of record showing them to be obvious variants. Because the Groups are distinct for these reasons and there is a serious burden on the Examiner if restriction is not required, the Office contends that restriction is proper.

Applicant elects, with traverse, to prosecute the invention of Group IV, claims 25-33. Applicant's traversal is not on the grounds that the claims as categorized by the Office are not

patentably distinct, but rather on the grounds that the Office has not substantiated that restriction between the claims as categorized is warranted.

To begin with, the Office has not even shown—or less alleged—that the claims for Groups I and Group II are independent. 35 U.S.C. § 121 requires that for restriction to be proper, the Office must show that groups of claims are both independent and distinct. *See also M.P.E.P. §§ 802; 802.01*. The Office, however, has only alleged that the claims are distinct for these reasons given above.

The Manual of Patent Examining Procedure (M.P.E.P.) sets forth those instances where the Office can impose a restriction requirement. As set forth in the first paragraph of M.P.E.P. § 803, the Office can impose a restriction requirement where the inventions are independent or distinct. The next paragraph, however, creates an exception.

If the search and examination of all the claims in an application can be made without serious burden, the examiner **must** examine them on the merits, **even though they include claims to independent or distinct inventions**.

M.P.E.P. § 803 ¶ 2 (emphasis added). It is noted that the Office has categorized all of the Groups of claims as being classified in class 601, subclass 2. By definition, in order to search any Group of the claims, the Examiner would automatically have to search all of the other Groups. Thus, there exists no serious burden to examine all of the claims together.

At the very least, it would appear that the claims from Group I (claims 15-20) and Group IV (claims 25-33) should be categorized and examined together. Specifically, claims 25-33 relate to an ultrasonic radiation micro-bubble reagent for causing embolus. Claims 15-20 relate to a method for embolizing blood vessels in which the ultrasonic radiation micro-bubble reagent of claims 25-33 is an important technical element.

Accordingly, the Office has not established a proper restriction requirement between the Groups and Applicant requests withdrawal of this restriction requirement and examination of all pending claims. At the very least, Applicant respectfully requests modification of the restriction requirement as outlined above and the examination of the claims in Group I along with the claims of Group IV.

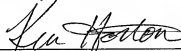
CONCLUSION

For the above reasons, Applicant respectfully requests the Office to withdraw the restriction requirement and examine all the pending claims. At the very least, Applicant respectfully requests modification of the restriction requirement as outlined above.

If there is any fee due in connection with the filing of this Response, including a fee for any extension of time not accounted for above, please charge the fee to our Deposit Account No. 50-0843.

Respectfully Submitted,

By



KENNETH E. HORTON

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Date: September 14, 2007